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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,344	10/29/1999	MICHAEL R. O'BRIEN	LOT9-99-0001	8551

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EXAMINER	
FIELDS, COURTNEY D	
ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/431,344	O'BRIEN ET AL.	
	Examiner	Art Unit	
	Courtney Fields	2137	

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Remarks

Claims 1-20 are pending.

On August 12, 2004, the Applicants resubmitted a copy of an amendment filed on March 25, 2004 along with corroborating evidence that the March amendment was properly mailed according to PTO rules. Accordingly, the August 12, 2004 copy of the March amendment has been accorded a filing date of March 25, 2004.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims describe a computer data signal embodied in a carrier wave. A carrier wave is not a process, machine, manufacture, or composition of matter. It is therefore not statutory subject matter within the scope of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over How to Set up the Paladin E-mail Client, www.circa.ufl.edu/handouts/softdist/paladin/paladin.html, pp. 1-6, August 18, 1997, in view of Crocker, D., Standard for the Format of ARPA Internet Text Messages, RFC-822, IETF, pp. 1-39, August 13, 1982, and PGP for Personal Privacy, v 5.5, User Guide, Network Associates, Inc., pp. 1-150, 1998, and the Admitted Prior Art.

Regarding claim 1, the Paladin System teaches the invention substantially as claimed because it teaches an offline system for composing email that later sends a message when the user goes online (p. 6 off line message is composed and marked as queued for sending).

The Paladin System does not teach a system that (1) inserts an encryption flag in a header associated with an electronic message/email; (2) places the header and the

plain text message in an outbox; (3) when the sender is online, in response to the flag, requests the digital certificate from the mail system; and (4) uses the received certificate to encrypt the plain text mail message.

RFC-822 on the other hand teaches an email message with an encryption flag in the header (pp. 16 and 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Paladin System implement email message formats according to the RFC standard, thereby including an encrypted flag in the email message because use of the encrypted flag would indicate to the recipient that the message was encrypted, thereby allowing the recipient of the message to decrypt the message.

The combination of the Paladin System in view of RFC-822 does not teach a method in that (2) places the header and the plain text message in an outbox; (3) when the sender is online, in response to the flag, requests the digital certificate from the mail system; and (4) uses the received certificate to encrypt the plain text mail message.

PGP for Personal Privacy on the other hand describes how some email agents encrypt email messages after they are placed in an outbox and before the messages are sent (p. 52, particularly the NOTE).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine PGP for Personal Privacy's teaching regarding the encryption of email at the time the message is sent with the method of the combination of the Paladin System in view of RFC-822 by having the method encrypt the sent email

message after the user goes back online because of PGP for Personal Privacy's express teaching that some email systems operate in this manner (p. 52). In the resulting combination, the method would move queued to send email into the outbox when the sender goes online and then encrypt the email message.

The combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy as discussed in the previous paragraph does not teach a method that requests a digital certificate from the mail system; and uses the received certificate to encrypt the plain text mail message.

The PGP for Personal Privacy also teaches a method in which when a email message sender does not have a recipient's certificate and public key, that information is requested from a key server (pp. 45-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine PGP for Personal Privacy's teaching regarding the retrieval of a certificate from a key server with the method of the combination of the Paladin System in view of RFC-822 by having the email agent request a locally unavailable certificate from a key server because of PGP for Personal Privacy's explicit teaching that these are alternative ways of getting keys/certificates (p. 45).

In the method of the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy, the certificate used to encypt the email message comes from a key server as opposed to the mail system.

The APA on the other hand describes the Lotus Notes system - an integrated groupware system that combines, among other things, an email server and a directory server that provides X.509 certificates (pp. 2-3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy to use an integrated email system and key server as taught by the APA. This modification would have been obvious because an integrated software solution makes the software provider responsible for the integration of the components, thus reducing the administration burden on the purchaser of the software.

Regarding claim 2, the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy and the APA teaches a method of sending the encrypted email message to the mail system (PGP for Personal Privacy p. 52).

Regarding claim 3, the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy and the APA teaches a method further comprising, when the sender is on-line, if the flag indicated that the message is encrypted, sending the encrypted email message to the mail system (RFC-822 pp. 16 and 21; PGP for Personal Privacy p. 52).

Regarding claim 4, the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy and the APA teaches the step of requesting the digital certificate from the mail system and, if the certificate is unavailable, informing the sender that the message cannot be encrypted (PGP for Personal Privacy pp. 45-46).

Regarding claim 5, the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy and the APA teaches a method further comprising sending the unencrypted message in the outbox to the mail system when the message cannot be encrypted (PGP for Personal Privacy pp. 45-46).

Regarding claim 6, the combination of the Paladin System in view of RFC-822 and PGP for Personal Privacy and the APA teaches a method wherein the header comprises information identifying the recipient (RFC-822 p. 15 "To") and using the identifying information to locate the recipient in the mail system and retrieve the certificate (PGP for Personal Privacy pp. 45-46).

Regarding claims 7-12, they are apparatus claims corresponding to method claims 1-6, respectively. Since they do not teach or define above the information in the corresponding method claims, they are rejected under the same basis.

Regarding claims 13-18, they are computer program product claims corresponding to method claims 1-6, respectively. Since they do not teach or define above the information in the corresponding method claims, they are rejected under the same basis.

Regarding claims 19-20, they are carrier wave claims corresponding to method claims 1-2, respectively. Since they do not teach or define above the information in the corresponding method claims, they are rejected under the same basis.

R sponse to Arguments

Applicant's arguments filed on March 25, 2004, with respect to the prior art rejections of the claims have been fully considered and are persuasive. The rejections have therefore been withdrawn.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. As to Vandergeest, U.S. Patent No. 6,247,127, it describes a system that retrieves user certificates when the system goes offline (col. 4 lines 8-28) as opposed to the claimed system, where a certificate is retrieved when the system goes online. As to Caputo et al., U.S. Patent No. 5,778,071, it describes a system in which messages are encrypted before they are queued to be sent (i.e., put into an outbox). In other words, Caputo describes a prior art system as discussed by the Applicants in the first complete paragraph on page 8 of the remarks in the response filed on March 25, 2004.

A shortened statutory period for response to this action is set to expire **three months** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney Fields, whose telephone number is (571) 272-3871. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, Andrew Caldwell, can be reached at (571) 272-3868.

Andrew Caldwell

Courtney Fields
703-306-3036
January 22, 2005

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER